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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.           | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------|
| 09/398,914  | 09/16/1999  | NED HOFFMAN          | STA-21                        | 1647             |
| 60460 7590 04/09/2007<br>MARGER JOHNSON & MCCOLLOM/INDIVOS<br>210 SW MORRISON STREET<br>SUITE 400<br>PORTLAND, OR 97204 |             |                      | EXAMINER<br>AUGUSTIN, EVENS J |                  |
|   |             |                      | ART UNIT<br>3621              | PAPER NUMBER     |
| SHORTENED STATUTORY PERIOD OF RESPONSE  |             | MAIL DATE            | DELIVERY MODE                 |                  |
| 3 MONTHS  |             | 04/09/2007           | PAPER                         |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/398,914

Applicant(s)

HOFFMAN ET AL.

Examiner

Evens Augustin

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-72, 101 and 102 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-72, 101 and 102 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Acknowledgements*

1. The amendment filed on 08 January 2007 has been acknowledged. Effective of date of 17 May 1994 is acknowledged. Claims 73-100 have been canceled. Claim 102 has been added. Claims 1-72 and 101-102 are pending.

### *Double Patenting*

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101. Applicant's arguments filed on 6/19/2006 are therefore moot.


3. Claims 1 and 20 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 14 and 15 of prior U.S. Patent No. 6,012,039. This is a double patenting rejection. (See appendix A). Independent claims 25, 54, 164, 101 and 102 are not patently distinct from claims 1 and 20, and are rejected under the same statute. All claims that depend on the independent claims are rejected as well.

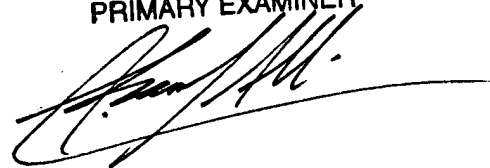
*Allowable Subject Matter*

4. Claims 1-72 and 101-102 would be allowable if the double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope and after possible pending prior art search (if required).

**Conclusion**

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.
6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

  
Evens J. Augustin  
March 28, 2007  
Art Unit 3621

KAMBIZ ABDI  
PRIMARY EXAMINER  


Appendix A

| Limitations | US 5613012– <i>Claim 38</i>  | Current Application<br>09398914 - <i>Claim 1</i>   |
|-------------|--|--|
| 1           | registration step, wherein at least one biometric sample is gathered, and a personal identification code and private code are selected and stored, wherein the private code is not used for gaining access to the computer system  | a user registration step, wherein a user registers with an electronic identifier at least one registration biometric sample taken directly from the person of the user   |
| 2           | an execution step wherein a command is processed and executed to produce a determination; an output step wherein said identification result or determination (or pattern) is externalized and displayed;   | formation of a user rule module customized to the user in a rule module clearinghouse, wherein at least one pattern data of a user is associated with at least one execution command of the user   |
| 3           | a comparison step wherein the biometric sample and personal identification code gathered during the bid step is compared with biometric samples and personal identification codes gathered and stored during the registration step, for producing either a successful or failed identification result; | a user identification step, wherein the electronic identifier compares a bid biometric sample taken directly from the person of the user with at least one previously registered biometric sample for producing either a successful or failed identification of the user   |
| 4           | wherein on successful identification of the individual, the private code is presented to the individual being identified, for authenticating the system to the individual (conducted without the user presenting smartcards or magnetic swipe cards – is implied)                                      | wherein upon successful identification of the user at least one previously designated rule module of the user is invoked to execute at least one electronic transmission; wherein a biometrically authorized electronic transmission is conducted without the user presenting smartcards or magnetic swipe cards |

Appendix A (cont'd)

| <b>Limitation</b> | <b>US 5613012 – Claim 1</b>   | <b>Current Application<br/>09398914 - Claim 20</b>  |
|-------------------|---|---|
| 1                 | first gathering and display means for voluntary input of at least one biometric sample, personal identification code, and a private code from an individual during the registration step, wherein the private code is not used for gaining access to the system | a biometric input apparatus, for providing a bid or registration biometric sample of a user to the electronic identifier, wherein a user registers with an electronic identifier at least one registration biometric sample taken directly from the person of the user                          |
| 2                 | execution means within said computer for storage of data and processing and execution of commands for producing a determination; means for output of said evaluation, determination, or private code from said computer;  | an electronic rule module clearinghouse, having at least one customizable rule module further comprising at least one pattern data of the user associated with at least one execution command of the user, for executing at least one electronic transmission                                   |
| 3                 | means for comparison of biometric sample and personal identification code gathered during the bid step with the biometric samples and personal identification codes gathered during the registration step, for producing an evaluation                          | an electronic identifier, for comparing the bid biometric sample with registered biometric samples of users   |
| 4                 | execution means within said computer for storage of data and processing and execution of commands for producing a determination;  | a command execution module, for invoking at least one previously designated execution command in the electronic rule module clearinghouse to execute an electronic transmission; wherein no smartcards or magnetic swipe cards are presented by the user to conduct the electronic transmission |